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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,745	11/20/2001	Mark S. Garrison	680.0039USU	9671

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,745

Applicant(s)

GARRISON ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12-18,20 and 22-35 is/are pending in the application.
- 4a) Of the above claim(s) 31-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-10, 13-18, 20, and 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of Amendment filed on November 28, 2003. Claim objections as indicated in the previous Office dated August 26, 2003 is maintained for the reasons of record and as explained below. Claim rejection made under 35 U.S.C. § 112, first paragraph is withdrawn in view of the claim amendment. Claim rejection made under 35 U.S.C. § 112, second paragraph is withdrawn in part in view of claim cancellation, but maintained for the reasons of record and as explained below. Claim rejection made under 35 U.S.C. § 103 (a) over Barnett et al. (US 5248495) in view of Patterson et al. (US 5248495) as indicated in the previous Office action is withdrawn in view of applicants' claim amendment. Claim rejection made under 35 U.S.C. § 103 (a) over Zastrow et al. (US 5667772) in view of Bratescu et al (US 6528070 B1) indicated in the same Office action is withdrawn in view of applicants' claim amendment, but modified to meet new claim limitations. Claims 1, 3-10, 12-18, 20, 22-35 are pending, of which claims 31-35 have been withdrawn from consideration. ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). In this case, applicants have not cancelled claims 31 and 32, and these claims remain withdrawn from consideration on the merits.

Misnumbered claims 31-33 been renumbered to 33-36.

Claims 8 and 9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 8 and 9 recite that the composition of claim 1 is placed in a jar, and a container having adjustable inner volume. Applicants' argument that the container "can be a feature that impacts the physical properties of the composition" has been noted. However, it is respectfully pointed that the subject matter of claim 1 is a composition. The type of container in where the composition is place does not change the structural limitation of the composition. Examiner views that claims 8 and 9 fail to further limit the composition of claim 1. ***Election/Restrictions***

Newly submitted claims 33-35 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 33 and 34 are directed to "system" claims which is a distinct invention from composition claims. Claim 35 is directed to method of renewing the surface appearance of a composition (or method of making a composition). In the May 1, 2003 response to restriction requirement, applicants elected composition claims, which are claims 1-30. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 33- 35 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-10, 12-18, 20, 22-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "textured surface appearance" in claim 1 renders the claim vague and indefinite. While applicants assert that any composition having granules, bubbles, or foam would also meet the limitation, examiner notes that the specification is not read into the claim in claim interpretation. The metes and bounds of the scope of the claim are unclear because it cannot be determined how a skilled artisan can determine a composition surface appears to be textured or smooth. Would the appearance of rich lather, which appears to be smooth, meet the limitation since it is foam?

The term "pre-determined period of time" in claim 1 renders the claim vague and indefinite. Applicants' disclosure does not indicate the meaning of the term or how to ascertain or measure that time period. While applicants assert that the term is well known, examiner takes the position that the term as recited in the present claims is vague and indefinite because it is not clear what would meet the metes and bounds of the claim limitation. Does the pre-determined time mean 1 hour?

The remaining claims are rejected as depending on indefinite base claims.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1, 3-10, 12-18, 20, and 22-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zastrow et al. (US 5667772) in view of Slinn (US 5143652) and Bratescu et al. (US 6528070 B1).

Zastrow teaches a cream composition comprising aqueous fluorocarbon emulsion. See example 1. The reference teaches that 0.05-80% by weight of the fluorocarbon emulsion may be used in the invention, wherein the fluorocarbon may be in the range from 20-100% weight/volume. See col. 3, lines 18-22; Exemplary embodiments. The reference teaches that perfluoroalkane having 6-9 carbons are among the preferred fluorocarbon. See col. 1, lines 61-67. The reference teaches that the fluorocarbons – perfluorinated or highly fluorinated- have oxygen solubility, partial vapour pressure, and further teaches to mix various fluorocarbons to improve the rate of penetration of the skin. See col. 2, line 53 – col. 3, line 4; instant claims 12-22. The reference teaches that the invention may be in the form of liquid, semi-liquid, or solid, and discloses the specific examples of applications such as cream, face mask, gel, etc. See instant claim 10.

While the reference does not specifically teach that the invention has “textured surface appearance”, or “original, textured surface appearance”, given the indefinite scope of the limitation, examiner takes the position that the composition having same volatile perfluoro or partially fluorinated composition meeting the claim limitation, in the same amount in the same oil-water emulsion cream form as the instant claims require, the prior art composition obviously has the physical characteristics recited in the instant claims. See instant claims 1 and 7. Examiner views that whether the composition is

placed in a jar having adjustable inner volume does not affect the structural limitation of the composition itself nor does it change the properties of the composition. See instant claims 8 and 9. The reference also teaches that the perfluoroalkne mixture having the boiling range between 100-140 °C, which is within the claimed range of the boiling point of a volatile compound. See exemplary embodiment II. Examiner views that the physical property such as vapor pressure is inseparable from the compound.

The reference fails to provide specific viscosities of the compositions.

Bratescu teaches cosmetic emulsions. The reference teaches that the viscosity of the composition can vary from thin as 100 cps, to cream like consistency of 80,000 cps. See col. 13, lines 33-35.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have adjusted the viscosity of the Zastrow compositions to the viscosities as motivated by Bratescu, because of an expectation of successfully producing the cosmetic compositions with desired viscosities.

Response to Arguments

Applicant's arguments filed November 28, 2003 have been fully considered but they are not persuasive.

Applicants' arguments regarding the rejection made over Barnet over Patterson are moot since the rejection is withdrawn.

Regarding the rejection made over Zastrow in view of Brastescu, applicants assert that the combination of the references is not properly made allegedly because the Brastescu patent fails to teach a volatile compound. Examiner respectfully

disagrees. Brastescu patent was cited to show that formulating a cosmetic composition within the applicants' limitation would have been obvious to a routineer in the field. Whether a volatile component is used in the Brastescu patent would not negate the fact that it is well known in the art to formulate a cosmetic composition within the claimed range of viscosities.

Conclusion


No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina Yu
Patent Examiner


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER